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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,590	08/16/2001	Dominique Pavlin	NO15-12PC	2876

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EXAMINER

HENNING, MATTHEW T

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/913,590	Applicant(s) PAVLIN ET AL.	
	Examiner Matthew T Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☒ Claim(s) 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>12/13/04 12/15/04</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/16/2001</u> . | 6) <input type="checkbox"/> Other: _____. |

This action is in response to the communication filed on 8/16/2001.

DETAILED ACTION

1. Claims 1-22 have been cancelled by applicant's preliminary amendment, dated 12/16/2004.
2. Claims 23-44 have been examined.

Title

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "System, method, and server for creating and distributing a divided software package in order to prevent the software from being pirated".

Priority

4. The application is a 371 of PCT/FR00/00406, filed 02/17/2000, claiming priority to France application 9902139, filed 02/17/1999.
5. The effective filing date for the subject matter defined in the pending claims in this application is 02/17/1999.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 08/16/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

7. The drawings filed on 08/16/2001 are acceptable for examination proceedings.

Specification

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

9. The abstract of the disclosure is objected to because

The abstract is not in the form of a single paragraph.

Line 3: The phrase "The present invention relates to" can be implied and therefore must be removed.

Correction is required. See MPEP § 608.01(b).

10. The disclosure is objected to because of the following informalities: Page 3 line 21 recites "a step of" and therefore should be removed from the specification.

Appropriate correction is required.

Claim Objections

11. Claims 32-33 are objected to for failing to conform to standard claim numbering.

Because Claim 32 refers to a system, and in order to be consistent with the rest of the claims, the examiner will presume for purposes of searching prior art that claim 32 was meant to depend from claim 30.

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The applicant is reminded that a series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 23-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd.

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App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

15. Claims 23, 30, and 38 recite the broad recitation “digital entities”, and the claims also recite “in particular software, files, compact disks, video disks, etc...” which is the narrower statement of the range/limitation. The ordinary person skilled in the art would be unable to determine whether the second recitation was meant to limit the claim to only those digital entities, or whether other digital entities, such as floppy disks or flash drives, were meant to be included in the scope of the claim. Therefore the scope of the claim is not defined and claims 23, 30, and 38 are rejected for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

16. Claims 27-28, 34, 36, and 42-43 recite the broad recitation “clients”, and the claims also recite “in particular potential clients” which is the narrower statement of the range/limitation. The ordinary person skilled in the art would be unable to determine whether the second recitation was meant to limit the claim to only potential clients, or whether other clients, such as current clients, were meant to be included in the scope of the claim. Therefore the scope of the claim is not defined and claims 27-28, 34, 36, and 42-43 are rejected for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

17. Claims 28, 36, and 43 recite the broad recitation “analyzing events”, and the claims also recite “in particular the succession...during an evaluation stage” which is the narrower statement of the range/limitation. The ordinary person skilled in the art would be unable to determine whether the second recitation was meant to limit the claim to only those event analysis, or whether other event analysis, such as the number of copies of the digital entity currently being

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accessed, were meant to be included in the scope of the claim. Therefore the scope of the claim is not defined and claims 28, 36, and 43 are rejected for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

18. The term "degree of client satisfaction" in claims 28, 36, and 43 is a relative term which renders the claims indefinite. The term "degree of client satisfaction" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The person of ordinary skill in the art would be unable to determine what constitutes a "degree of client satisfaction" and therefore would be unable to determine the scope of the claim.

19. Any claim not specifically mentioned above is rejected by virtue of its dependency to an above rejected claim.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

21. Claims 23-27, 29-35, 37-42, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark (US Patent Number 6,343,280).

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22. Regarding claim 23, Clark disclosed a method creating a link between at least one user and a publisher (See Clark Software Vendor) of digital entities (in particular software, files, compact disks, video disks, etc. ...) that are reproducible by computer and/or electronic means; said digital entities being initially designed for use or execution solely on a single piece of user computer equipment (See Clark Col. 4 Line 66 – Col. 5 Line 19); said method comprising the following steps: subdividing said digital entity two portions, first portion and a second portion, neither of which portions can be run without the other (See Clark Col. 14 Lines 34-40); storing said first portion in a memory zone of a server connected to a computer network (See Clark Col. 14 Lines 40-43 wherein it was inherent that the server stored the removed executable instructions in order for them to be executed at a later time); transmitting said second portion to at least one user having computer equipment including computer means for implementing said second portion (See Clark Col. 14 Lines 45-48); installing said second portion on said computer equipment (See Clark Col. 14 Lines 51-54); connecting said computer equipment said computer network (See Clark Col. 15 Lines 43-49); and establishing functional link between said first portion and said second portion (See Clark Col. 15 Lines 43-56); whereby, when said second portion is put into operation, it automatically makes a connection via the computer network to said server in order to execute the said missing first portion as stored said server (See Clark Col. 15 Line 56 – Col. 16 Line 36).

23. Regarding claim 24, Clark disclosed exchanging information relating to said digital entity by means of said functional links; whereby a community of users exchanging information is established (See Clark Col. 15 Line 56 – Col. 16 Line 36 and Col. 21 Lines 21-37).

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24. Regarding claim 25, Clark disclosed controlling access to said server; whereby a user can access said first portion and use said digital entity only if the user possesses access rights (See Clark Col. 16 Lines 14-17).

25. Regarding claim 26, Clark disclosed controlling and limiting access to said server to a limited period of time and/or to a limited number of uses and/or to an approved population of users; whereby the user can make use of such digital entity in full only during an evaluation stage and/or any stage agreed to with the publisher (See Clark Col. 21 Paragraph 2).

26. Regarding claim 27, Clark disclosed identifying the user on making a connection to said server (See Clark Col. 15 Lines 42-45); and storing identifiers specific to said user (See Clark Col. 17 Line 16); whereby the publisher of said digital entity can reference clients, in particular potential clients of said digital entity (See Clark Col. 16 Lines 16-19).

27. Regarding claim 29, Clark disclosed downloading the first portion of said digital entity into the computer equipment of the user; whereby a user who has decided to acquire said digital entity can immediately have it available locally (See Clark Col. 33 Line 44 – Col. 34 Line 41 wherein the removed instruction sequences were downloaded to the user and placed in the secure server software object, where they were run when necessary).

28. Claim 30 is rejected for the same reasons as claim 23 above and further because Clark disclosed the method of claim 1 in a system (See Clark Claims).

29. Claim 31 is rejected for the same reasons as claim 24, as applied to claim 30.

30. Claim 32 is rejected for the same reasons as claim 25, as applied to claim 30.

31. Claim 33 is rejected for the same reasons as claim 26, as applied to claim 32.

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32. Claims 34-35 are rejected for the same reasons as claim 27, as applied to claim 30, and further because Fig. 3 clearly depicted the license server accomplishing these tasks.

33. Claim 37 is rejected for the same reasons as claim 29, as applied to claim 30.

34. Claims 38-42 and 44 are rejected for the same reasons as claims 23-27 and 29 respectively, and further because Clark disclosed a license server accomplishing these tasks (See Fig. 3 and above rejections), and because the server was connected to a network (See Clark Col. 4 Line 66 – Col. 5 Line 19).

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

36. Claims 28, 36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark as applied to claims 23, 30, and 38 above, and further in view of Pressman (“Software Engineering A Practitioner’s Approach”).

Clark disclosed analyzing events linked with using said digital entity (See Clark Col. 30 Line 19 – Col. 31 Line 44), but failed to disclose having a panel of users co-operating in testing the software, from which the vendor can determine client satisfaction.

Pressman teaches that when software is developed for many customers, alpha and beta testing is used to uncover errors that only users seem to be able to find. In beta testing, the users

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run the software in their own environment and provide feedback about the software to the developer (See Pressman section 17.5.3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Pressman in the software distribution system of Clark by providing beta testing of the software. This would have been obvious because the ordinary person skilled in the art would have been motivated to uncover hidden errors in the software and fix them before releasing the software to its entire customer base.

Conclusion

37. Claims 23-44 have been rejected.

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Shavit (US Patent Number 6,009,543) disclosed a system for running a divided program partially on a server and partially on a client computer in order to protect the software from piracy.

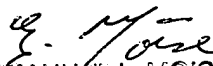
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39. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (571) 272-3790. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST. If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (571) 272-3795. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Matthew Henning
Assistant Examiner
Art Unit 2131
12/22/2004


EMMANUEL L. NOISE
PRIMARY EXAMINER